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09/916,546	07/27/2001	John H. Schneider	769-283	8553
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PITNEY HARDIN LLP			PICKETT, JOHN G	
7 TIMES SQUARE			ART UNIT	
NEW YORK, NY 10036-7311			PAPER NUMBER	

3728

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/916,546
Filing Date: July 27, 2001
Appellant(s): SCHNEIDER, JOHN H.

Ronald E. Brown
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 18 January 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) Grouping of Claims

The appellant's brief does not contain a statement of the grouping of the claims.

The appellant's brief is in compliance with 37 C.F.R. 41.37.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,115,892	Malin et al.	09-2000
5,647,671	May, Timothy J.	07-1997
6,212,857	Van Erden, Donald L.	04-2001
5,023,122	Boeckmann et al.	06-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6, 8, 10, 11, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over MALIN et al. (US 6,115,892) in view of MAY (US 5,647,671) and VAN ERDEN (US 6,212,857). This rejection is set forth in a prior Office Action, mailed on 10 March 2004.

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over MALIN et al. in view of MAY and VAN ERDEN as applied to claim 6, and further in view of BOECKMANN et al. (US 5,023,122). This rejection is set forth in a prior Office Action, mailed on 10 March 2004.

(11) Response to Argument

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation can be found in the prior art of record.

MALIN et al discloses leading flanges (see Figure 1, items 22 and 24; these leading flanges are named first and second flanges, respectively, by the appellant) that are of equal length and joined by portion (20). As disclosed by MALIN et al, the leading flanges (22, 24) are sealed to web (34) together, with the seal penetrating multiple film layers (22, 24, 34). MALIN et al is the base reference which is modified with separate and differing sized leading flanges as taught and suggested by MAY for the purpose of seal strength control (May, Figures 5 and 6, and Column 8, lines 52-58). MAY states, "control is due to the fact that the heat used to form the peelable seal only must

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penetrate through the top film 82, as opposed to the top film 82 along with other layers of material.” (Column 8, lines 55-58) Thus the examiner contends that MAY provides the appropriate motivation for combination with MALIN et al. and requests the rejection be sustained

In response to the appellant’s argument that the combination would alter the principle of operation of MALIN et al, MALIN et al states as an object of invention as the provision of “a zipper strip for use in transverse-zippered reclosable plastic bags having two leading flanges which overcomes the aforementioned flaring problem.” (Column 2, lines 36-39) The examiner has referred to this feature as a “ramp feature”. The examiner asserts that the provision of the first (22) flange as separate from, and shorter than, the second (24) flange would in no way destroy the “ramp feature”. Appellant’s reference to flanges extending in the direction opposite to the machine direction is directed to trailing flanges, which do not effect the operation of the “ramp feature”. Thus the examiner contends that the rejection is proper and requests the rejection be sustained.

In response to the appellant’s argument that the combination fails to suggest a slider-equipped zipper, the examiner contends that VAN ERDEN suggests the provision of the slider upon the zipper prior to entry of the FFS machine (see Figure 2). The appellant notes that VAN ERDEN also requires the leading flanges to be attached to each other. The examiner contends that the teaching of MAY with regards to the seal

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strength would apply to VAN ERDEN. Thus, the examiner contends that VAN ERDEN suggests the method step of provision of the slider upon the zipper prior to the entry into the FFS machine and requests the rejection be sustained.

In response to appellant's argument that MAY is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, MAY is in the appellant's field of endeavor.

In response to the appellant's argument that the examiner has failed to consider the disparate teachings of the prior art as a whole, MAY is concerned with closure arrangement and seals that are relatively insusceptible to small manufacturing variations (Column 2, lines 61-63). Contrary to appellant's assertion that "close inspection of the figures in May show that the zipper strip is not applied to the film traverse to the machine direction", the examiner asserts that MAY is silent on this issue. One of ordinary skill in the art would have not been led in either direction by reading MAY and the examiner contends that silence on the issue does not lead one away from the claimed invention. Thus, the examiner asserts that the rejection is proper and requests the rejection be sustained.

In response to appellant's argument that the examiner has failed to show a reasonable expectation of success, the examiner asserts that VAN ERDEN suggests the claimed method and shows that a slider may be applied to a transverse-mounted zipper prior to entry into a FFS machine (see Figure 2). Thus, the examiner contends that a reasonable expectation of success has been met and requests the rejection be sustained. As to the overall flange arrangement of the combination, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The examiner contends that a *prima facie* case of obviousness for claim 1 has been set forth and requests the rejection be sustained.

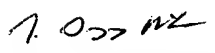
Appellant bases the arguments for claims 2-4, 6, 8, 10, 11, and 13-15 on the allowability of claim 1. The examiner contends that a *prima facie* case of obviousness has been set forth for claim 1. As presented in the Office Action of 10 March 2004, the combination of MALIN-MAY-VAN ERDEN discloses all of the claimed limitations and the examiner requests the rejection of claims 2-4, 6, 8, 10, 11, and 13-15 be sustained.

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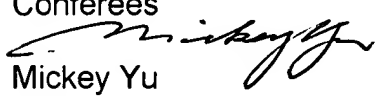
Appellant bases the argument for claim 7 on the allowability of claim 1. The examiner contends that a *prima facie* case of obviousness has been set forth for claim 1. As set forth in the Office Action of 10 March 2004, the combination of MALIN-MAY-VAN ERDEN-BOECKMANN discloses all of the claimed limitations and the examiner requests the rejection of claim 7 be sustained.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


John Gregory Pickett
Examiner
February 11, 2005

Conferees


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